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ADAMS, D

SERIAL NUMBER	FILING DATE	FIRST E. ANTHONY FIGG ROTHWELL FIGG ERNST & KURZ SUITE 701 E. 555 10TH STREET, NW WASHINGTON, DC 20004	18N1/0304 NAMED APPLICANT	ATTORNEY DOCKET NO. 1816
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03/04/96	
EXAMINER	
ART UNIT	PAPER NUMBER
33	

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application

Commissioner of Patents

1. After review of this application, the Advisory Action, mailed February 15, 1996, was in error. The request under 37 CFR § 1.129(a) was not entered into this application at the time the Advisory Action was mailed.
2. The request under 37 CFR § 1.129(a) has been entered and this application will be examined in due course. The Advisory Action was been withdrawn and the time periods reset.
3. Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4227.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald E. Adams whose telephone number is (703) 308-0570. The examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Christina Chan can be reached at (703) 308-3973. The fax phone number for Group 1806 is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 180 receptionist whose telephone number is (703) 308-0196.

March 1, 1996

Donald E. Adams, Ph.D.  
Primary Examiner  
Group 1800

15. Claims 15-31 have been cancelled.
16. Claims 1-14 are currently pending.
17. Claims 1 and 11 have been amended.
18. Formal drawings and photographs have been submitted which fail to comply with 37 CFR 1.84. Applicants' cancellation of Figure 1 is noted and is not deemed to introduce new matter. Applicants' request to hold in abeyance the formal drawing requirements is noted.
19. The following is a quotation of the first paragraph of 35 U.S.C. § 112:  

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by
18. Claims 1-14 are rejected and the specification is objected to under 35 U.S.C. § 112, first paragraph, as the disclosure is not enabling for the use of the claimed invention as a diagnostic aid or as a therapeutic agent.

*The Lewis declaration was not signed. However, the declaration was considered and would be persuasive if a signed declaration was presented.*

19. A. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

20. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

21. Claims 1-2, 4-5, 7-10, 12-14 are rejected under 35 U.S.C. § 103 as being unpatentable over Gillies et al. The invention is drawn to a process of recombinantly producing antibodies. Gillies et al. teach methods for the production of human (primate) antibodies (specifically anti-tetanus antibodies) from cDNA libraries, as well as transfected cell lines, transfecting vectors, and a recombinant human (primate antibody that would be useful for the treatment of tetanus poisoning (see Materials and Methods). Applicants' specification indicates that methods of inserting complete cDNA sequences into expression vectors were known before the time of invention of the claimed subject matter (see page 14, paragraph 2). Therefore it would have been prima facia obvious to a person of ordinary skill in the art at the time the invention was made to make recombinant antibodies as claimed by applicant according to Gillies et al.

*Applicant's position that Gillies probably removed the 3' untranslated sequence is not supported by evidence that this in fact is what Gillies did.*

22. Claims 3 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gillies et al. in view of Founy et al. (WO 87/01131) and Ehrlich et al. Applicant traverses on the grounds that Gillies et al. teach away from the claimed invention in that the insertion of intact cDNA is not taught. Applicant would appear to be arguing claim limitations not present. Even if such limitations were present, Applicants' specification indicates that methods of inserting complete cDNA sequences into expression vectors were known before the time of invention of the claimed subject matter (see page 14, paragraph 2). Applicants' claims, if amended to contain the argues limitations would be rejected under 35 USC 103 over Gillies et al. in view of the admitted prior art. Applicants' arguments have been considered but are not found persuasive.

*Applicant relies on the deficiency of Gillies to render this rejection invalid, as discussed above this is not persuasive.*

23. Claim 11 stands rejected under 35 U.S.C. § 103 as being

unpatentable over Gillies et al. in view of Lerrick et al. The claim is drawn to a method for the production of recombinant antibodies using micro-preps of RNA. Applicant argues that Gillies et al. requires the use of genomic DNA encoding the heavy chain of Ig molecules. Applicants' arguments appear to be directed to unclaimed elements believed to define over the prior art. Even if such limitations were present, Applicants' specification indicates that methods of inserting complete cDNA sequences into expression vectors were known before the time of invention of the claimed subject matter (see page 14, paragraph 2). Applicants' claims, if amended to contain the argued limitations would be rejected under 35 USC 103 over Gillies et al. in view of the admitted prior art. No such limitations exist in the claims, accordingly applicants' arguments are not found persuasive.

*Applicant relies on the deficiency of Gillies to render this rejection invalid, as discussed above this is not persuasive.*

24. No claim allowed.

25. Papers related to this application may be submitted to Group 180 by facsimile transmission. Papers should be faxed to Group 180 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4227.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald E. Adams whose telephone number is (703) 308-0570. The examiner can normally be reached Monday through Thursday from 7:30 to 6:00. A message may be left on the examiners voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Christina Chan can be reached at (703) 308-3973. The fax phone number for Group 1806 is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 180 receptionist whose telephone number is (703) 308-0196.

May 11, 1996

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